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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/668,438
Filing Date: September 23, 2003
Appellant(s): MILSTEIN ET AL.

Christopher Holt, Reg.No. 45844
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/06/2008 appealing from the Office action mailed 11/01/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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Yairi	US Publication 2004/10078424	April 22, 2004
Kay	US Publication 2003/10074410	April 17, 2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2,4-8,13-19,21-29, 34-37,39-46, 50-55, 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leber (US Publication 2003/0182391) in view of Yairi (US Publication 2004/0078424) further in view of Kay (US Publication 2003/0074410).

Leber disclosed (re. Claim 1,26,39,40,42, 57-58) a computer implemented method for task execution based on dialog-based communication with a communication service, comprising: receiving dialog from a user, the dialog being directed to a specialized entity (Leber-Paragraph 67, 'chat box') ; analyzing the dialog to identify a command; (Leber-Paragraph 68) and performing a task on the user's behalf based on

the command. (Leber-Paragraph 67)

While Leber substantially disclosed the invention as claimed, Leber did not disclose (re. Claim 1) determining whether the user is authorized to utilize the application necessary to complete the task, and performing the task only if the user is authorized.

Yairi disclosed (re. Claim 1) authenticating a user for billing according to transaction/services performed.

The Examiner notes that authorization of an IM user is widely known in the networking art since each user is required to register to a portal before being allowed access the IM system, and that authentication is widely known sub-step in the process of authorization. Yairi disclosed authentication in context of authenticating a user (Yairi-Paragraph 35-36) and not an object. Furthermore where the authentication is performed for purposes of billing the user for a particular service/transaction, it would be obvious to a person of ordinary skill in the networking art that there is implicit authorization being granted to the user for said service/transaction.

Furthermore Kay disclosed (re. Claim 1) wherein some transaction/services are restricted and permitting access only to certain users. (Kay-Paragraph 71-75)

Leber, Yairi, and Kay are analogous art because they present concepts and practices regarding presentation of web services via IM to a mobile user. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Yairi into Leber. The motivation for said combination would have been to overcome the shortcomings of SMS (Yairi-Paragraph 7).

Similarly it would have been obvious to a person of ordinary skill in the networking art to combine Kay into Leber-Yairi. The motivation for said combination would have been to avoid having the user enter separate passwords for each service desired. (Kay-Paragraph 24)

Thus Leber-Yairi-Kay disclosed (re.Claim 1) determining whether the user is authorized to utilize the application necessary to complete the task, and performing the task only if the user is authorized. (Yairi-Paragraph 50, Kay-Paragraph 71-75)

Claims 26,39,40,42, 57-58 are rejected on the same basis as Claim 1.

Furthermore Leber-Yairi-Kay disclosed (re. Claim 42) a communication service provider being further configured to present an option to extend access to a service necessary to complete the task. (Yairi-Paragraph 40, 'web service controller offers composite service as follow-up option')

Leber-Yairi-Kay disclosed (re. Claim 2,27,43) wherein analyzing the dialog to identify a command comprises analyzing the dialog to determine which of a variety of applications is necessary to complete the task. (Leber-Paragraph 78, Paragraph 91)

Leber-Yairi-Kay disclosed (re. Claim 6,44) utilizing the specialized entity to participate in dialog interaction with the user to guide the user in the production of said dialog. (Leber-Paragraph 204-205)

Leber-Yairi-Kay disclosed (re. Claim 15,34,52) wherein the communication service is an instant message communication service, and wherein receiving dialog from the user comprises receiving instant message dialog. (Leber-Paragraph 67, '*chat box*'))

Leber-Yairi-Kay disclosed (re. Claim 16,35,53) wherein the dialog is directed to a specialized buddy appearing on an instant messaging buddy list associated with the user. (Leber-Paragraph 267)

Leber-Yairi-Kay disclosed (re. Claim 17,36,54) wherein the communication

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service is a text messaging communication service, and wherein receiving dialog from the user comprises receiving text messaging dialog. (Leber-Paragraph 67, '*chat box*'))

Leber-Yairi-Kay disclosed (re. Claim 18,37,55) wherein the communication service is an email transport service, and wherein receiving dialog from a user comprises receiving an email addressed to the specialized recipient. (Leber-Paragraph 67, '*chat box*'))

Leber-Yairi-Kay disclosed (re. Claim 19) wherein analyzing the dialog to identify a command comprises parsing a textual content of the email. (Leber-Paragraph 43)

Leber-Yairi-Kay disclosed (re. Claim 21) wherein analyzing the dialog to identify a command comprises analyzing the dialog to identify a keyword. (Leber-Paragraph 43)

Leber-Yairi-Kay disclosed (re. Claim 22,23) performing a task on the user's behalf based on the command. (Leber-Paragraph 67)

Leber-Yairi-Kay disclosed (re. Claim 24,59) wherein performing a task on the

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user's behalf comprises interfacing with a calendar software application. (Leber-Paragraph 105)

Leber-Yairi-Kay disclosed (re. Claim 25,41) wherein execution of the command is contingent upon a set of predetermined circumstances, and wherein performing a task on the user's behalf comprises performing a task when the predetermined set of circumstances have occurred. (Leber-Paragraph 253, '*a periodic reminder*')

Leber-Yairi-Kay disclosed (re. Claim 4) presenting the user with an opportunity to become authorized when the user is not authorized to utilize the application necessary to complete the task. (Yairi-Paragraph 40, '*composite service offered to the user*', Paragraph 49)

Leber-Yairi-Kay disclosed (re. Claim 5) wherein presenting the user with an opportunity to become authorized comprises presenting the user with an opportunity to purchase access. (Yairi-Paragraph 40, '*composite service offered to the user*', Paragraph 49)

Leber-Yairi-Kay disclosed (re. Claim 7,28,45) wherein utilizing the specialized entity to participate in dialog interaction with the user comprises: presenting the user with a plurality of choices; and receiving from the user a selection of one of the plurality of choices. (Yairi-Paragraph 30)

Leber-Yairi-Kay disclosed (re. Claim 8,29,46) wherein performing a task on the user's behalf comprises performing a task tailored to the selection of one of the plurality of choices. (Leber-Paragraph 91)

Leber-Yairi-Kay disclosed (re. Claim 13,14,50,51) determining a geographic location of a device with which the user is communicating with the communication service. (Yairi-Paragraph 34, *' alerting to traffic information subsequent to providing driving directions (optionally further based on a location of the mobile terminal)'*)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-12,20, 30-33, 38, 47-49,56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leber (US Publication 2003/0182391) in view of Yairi (US Publication 2004/0078424) further in view of Kay (US Publication 2003/0074410) further in view of Kennewick (US Publication 2004/0193420).

While Leber-Yairi-Kay substantially disclosed the invention as claimed, Leber-Yairi-Kay did not disclose (re. Claim 9,30) performing a task tailored to a parameter listed in a profile associated with the user; (re. Claim 10,31,47) performing a task tailored to a preference associated with the user; (re. Claim 11,32,48) wherein the preference is set by the user; (re. Claim 12,33,49) wherein the preference is automatically set based on a history of user interactions with the specialized entity.

Kennewick disclosed (re. Claim 9, 10, 11,12,30,31,32,33,47,48,49) performing a task tailored to a parameter listed in a profile associated with the user;(Kennewick-Paragraph 11, *'user specific profile data'*). Kennewick disclosed (re. Claim 12,33,49) wherein the preference is automatically set based on a history of user interactions with the specialized entity. (Kennewick – Paragraph 32)

Leber,Yairi,Kay, and Kennewick are analogous art because they present concepts and practices regarding presentation of web services via IM to a mobile user.

At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Kennewick into Leber. The motivation for said combination would have been to allow for natural language speech queries or commands in a vehicular environment. (Kennewick-Paragraph 6)

While Leber-Yairi-Kay substantially disclosed the invention as claimed, Leber-Yairi-Kay did not disclose (re. Claim 20,38,56) wherein the communication service is an automated telephone system, and wherein receiving dialog from a user comprises receiving speech communication.

Leber-Yairi-Kay-Kennewick disclosed (re. Claim 20,38,56) wherein the communication service is an automated telephone system, and wherein receiving dialog from a user comprises receiving speech communication. (Kennewick-Paragraph 76)

Leber-Yairi-Kay and Kennewick are analogous art because they present concepts and practices regarding presentation of web services via IM to a mobile user. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Kennewick into Leber. The motivation for said combination would have been to allow for natural language speech queries or commands in a vehicular environment. (Kennewick-Paragraph 6)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leber (US Publication 2003/0182391) in view of Yairi (US Publication 2004/0078424) further in view of Kay (US Publication 2003/0074410) further in view of Mondragon (US Publication 2002/0103879).

While Leber-Yairi-Kay substantially disclosed the invention as claimed, Leber-Yairi-Kay did not disclose (re. Claim 60) wherein presenting the user with an opportunity to become authorized comprises presenting the user with an opportunity to accept free access.

Mondragon disclosed (re. Claim 60) wherein presenting the user with an opportunity to become authorized comprises presenting the user with an opportunity to accept free access. (Mondragon-Paragraph 7, Paragraph 14)

Leber-Yairi-Kay and Mondragon are analogous art because they present concepts and practices regarding presentation of web services via IM to a mobile user. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Mondragon into Leber-Yairi-Kay. The motivation for said combination would have been to provide free service for an unlimited period.
(Mondragon-Paragraph 6)

(10) Response to Argument

The Applicant presents the following argument(s) [in italics]:

very generally speaking, "authorized" in claim 1 is referring to a step that occurs before a task is performed, and "authenticating" in Yairi is referring a step that occurs while monitoring and providing feedback on the status of a request.

The Examiner notes that authorization of an IM user is widely known in the networking art since each user is required to register to a portal before being allowed access the IM system, and that authentication is widely known sub-step in the process of authorization. Yairi disclosed authentication in context of authenticating a user (Yairi-Paragraph 35-36) and not an object. Furthermore where the authentication is performed for purposes of billing the user for a particular service/transaction, a person of ordinary skill in the networking art would understand that there is implicit authorization being granted to the user for said service/transaction.

The Applicant presents the following argument(s) *[in italics]*:

Yairi paragraph 40, along with paragraph 41, discloses offering composite services (i.e. more than one service working together) to a user...This is not equivalent to the claimed process of presenting the user with an opportunity to become authorized when the user is not authorized to utilize the application necessary to complete the requested task.

The Examiner respectfully disagrees with the Applicant.

The Examiner notes that it would have been obvious to a person of ordinary skill in the networking art that the offer by Yairi implicitly includes authorization being granted to the user for said service/transaction. The Examiner does not sense any logic in presenting an offer to a subscriber, whereupon the subscriber accepts the offer, and subsequently finds that said subscriber is not authorized for the offered services.

The Applicant presents the following argument(s) *[in italics]*:

In the latest Office Action, in order to reject Appellant's claims 9-12 and 20, the Examiner cites four different references that, in the Examiner's estimation, would be obvious to combine...The Examiner provides no explanation, whatsoever, as to why it would be obvious to combine the teachings of all four references in order to arrive at the limitation of claims 9-12 and 20... The only conclusion that can be reached from the

alleged combinability of the references is the impermissible hindsight gleaned from the present invention.

The Examiner respectfully disagrees with the Applicant.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

Leber, Yairi, and Kay are analogous art because they present concepts and practices regarding presentation of web services via IM to a mobile user. (Leber-Paragraph 26, Paragraph 65, Yairi-Paragraph 37, Figure 2, Kay-Paragraph 25, Paragraph 10) At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Yairi into Leber. The motivation for said combination would have been to overcome the shortcomings of SMS (Yairi-Paragraph 7).

Similarly it would have been obvious to a person of ordinary skill in the networking art to combine Kay into Leber-Yairi. The motivation for said combination would have been to avoid having the user enter separate passwords for each service desired. (Kay-Paragraph 24)

Leber, Yairi, Kay, and Kennewick are analogous art because they present concepts and practices regarding presentation of web services via IM to a mobile user. (Kennewick-Paragraph 13, Paragraph 44) At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Kennewick into Leber-Yairi-Kay. The motivation for said combination would have been to allow for natural language speech queries or commands in a vehicular environment. (Kennewick-Paragraph 6)

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham*. An exemplary rationale that may support a conclusion of obviousness is that of 'applying a known technique to a known device (method, or product) ready for improvement to yield predictable results.'

While the entirety of their disclosures might be considered complex the pertinent disclosures by Yairi, Kay and Kennewick present relatively simple and known techniques that are readily applied to a known method by Leber.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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